

Appl. No. 10/734,718
Amdt. Dated 01/04/05
Reply to Office Action of 10/04/04

Remarks/Arguments

Applicant would like to thank the examiner for the thorough review of the present application. The examiner has rejected claims 1,2,5,6, and 9 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,530,571 to McWilliams in view of U.S. Patent No. 4,165,710 to Gaetano and U.S. Patent No. 3,190,653 to Karthaus. In order to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.

The examiner acknowledges McWilliams does not teach a hand-held device including a display screen and a plurality of dials and wheels for displaying a ball and strike count of a player, as recited in applicant's independent claims 1, 6, and 10. However, the examiner asserts it would have been obvious to one having ordinary skill in the art to combine the teachings of McWilliams with the hand-held score counting device of Gaetano to teach applicant's claimed invention. Applicant respectfully submits the game of McWilliams is based upon players answering questions correctly or incorrectly. If a player answers incorrectly, an out is recorded. If a player answers correctly, a hit is recorded. There is no provision in the game for strikes and balls. A player simply records an out or a hit, depending upon whether the question was answered correctly or not (See McWilliams col. 5, lines 9-56). As a result, there is no suggestion or motivation in McWilliams to include a hand-held scoring device for balls and strikes, because players do not incur balls and strikes, only outs and hits.

Furthermore, Gaetano's hand-held invention is intended for use by players in fast paced, player participative, physical sporting activities, to record and tabulate the progress of the game without distracting from the player's performance (See Gaetano col. 1, lines 10-24), not for slower paced board games such as the present invention wherein time is not of the essence. As a result, Gaetano teaches away from the claimed invention and there is no suggestion or motivation in McWilliams to include a

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hand-held scoring device such as the device in Gaetano, as noted above. That a prior art reference could be modified to form the claimed structure does not supply a suggestion to do so. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

The examiner acknowledges McWilliams does not teach playing pieces having upper and lower portions and including a spring member connecting the upper and lower portions so that when such game pieces are moved across the game board, the upper portion is caused to oscillate about the spring member, as recited by applicant's independent claims 1, 6, and 10. However, the examiner asserts it would have been obvious to one having ordinary skill in the art to include the playing pieces of Karthaus. Applicant respectfully submits the playing pieces of Karthaus disclose a plurality of spring members (See Karthaus' FIG. 5, items 223 and 225) connected to the upper portion P and the shaft 204 that must be positively engaged in order to enable the playing piece to oscillate and thereby move its simulated stick in a generally arcuate manner (See Karthaus' FIGS. 4-8). The playing pieces of the present invention include a single spring member connecting the upper and lower portion of the piece. When the playing piece is moved across the board, the upper portion is caused to oscillate because it is connected only by a spring member. Therefore, the mere movement of the piece causes the upper portion to oscillate. The spring member of the present invention does not have to be engaged like the springs of Karthaus do in order to cause the oscillation of the upper portion. Because the playing pieces of Karthaus teach positive engagement by the user in order to oscillate the playing piece, the playing piece of Karthaus would not oscillate if simply moved across the game board as the playing pieces of the present invention, and therefore, any hypothetical combination of Karthaus with the other prior art of record would not teach applicant's claimed invention. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

The examiner has rejected claims 3,4,7,8, and 10-12 under 35 U.S.C. § 103(a) as

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being unpatentable over U.S. Patent No. 6,530,571 to McWilliams in view of U.S. Patent No. 4,165,710 to Gaetano and U.S. Patent No. 3,190,653 to Karthaus and further in view of U.S. Patent No. D417,701 to Jack. The examiner acknowledges the combined teaching of McWilliams, Gaetano, and Karthaus does not teach a reusable score board having a dry-erase surface and including a substantially rectangular top member and a base member having a slot, the top member being removably engagable within the slot and slidably positionable therealong and further including a plurality of writing utensils, as recited by applicant's independent claim 10. However, the examiner asserts Jack discloses a multipurpose scoreboard with a writing implement holder and it would have been obvious to one of ordinary skill in the art to combine the teachings of Jack with the teachings of McWilliams, Gaetano, and Karthaus to teach applicant's claimed invention. Applicant respectfully submits the scoreboard of McWilliams discloses a plurality of scorecards connected thereto which may be flipped by a user to indicate the score, number of outs, and inning (See McWilliams FIG. 1, item 18). Therefore, a dry-erase scoreboard and writing utensils are unnecessary to keep score in McWilliams. As a result, there is no suggestion or motivation in McWilliams to include a dry erase scoreboard and writing implement because the necessary numbers are printed on the scorecards and a user only needs to flip the scorecards until the desired number appears. That a prior art reference could be modified to form the claimed structure does not supply a suggestion to do so. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989).

Applicant further submits the examiner has mischaracterized the Jack reference because applicant's independent claim 10 requires the top member of the scoreboard be removably engagable within the slot and slidably positionable therealong. The scoreboard of Jack is one piece and is not removably engagable with a base portion. As such, the scoreboard of the present invention can be more easily disassembled and stored. In addition, the scoreboard of the present invention simulates a real scoreboard in a baseball park, lending authenticity and the feel of a real ballpark to the game (See

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applicant's FIG. 6 and page 5, lines 10-12.) The scoreboard of Jack is an information display device, designed for writing and communicating messages, not keeping score of a baseball game. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. See *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

In addition, applicant respectfully submits the examiner has used improper hindsight reconstruction to teach applicant's claimed invention. It is impermissible for the examiner to pick and choose elements from several references to "build" an obviousness rejection. M.P.E.P. § 2145. Applicant further submits it is impermissible to use applicant's invention as a "road map" to piece together the teachings of the prior art in order to render the claimed invention obvious. The fact that a simple solution has escaped other workers in the art is some evidence that it was **not obvious** to a person of ordinary skill in the art. See *In re Shelby*, 311 F.2d 807, 810, 136 USPQ 220 (CCPA 1963) The fact that the examiner combined four references to teach applicant's claimed invention is evidence it was not obvious to one of ordinary skill in the art.

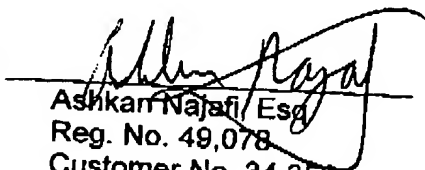
In view of these considerations, it is respectfully submitted that the rejection of the original claims should be considered as no longer tenable with respect to the above arguments. Should the examiner consider necessary or desirable to make formal changes anywhere in the specification, claims and/or drawings, then it is respectfully asked that such changes be made by examiner's Amendment, if the examiner feels this would facilitate passage of the case to issuance. Alternatively, should the examiner feel that a personal discussion might be helpful in advancing this case to allowance, he/she is invited to telephone the undersigned attorney.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

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